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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,494	06/30/2006	Christoph Matzig	MATZ3004/JEK	2909
23364 7590 08/11/2008 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
HAGEMAN, MARK				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
08/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/550,494

**Applicant(s)**

MATZIG, CHRISTOPH

**Examiner**

Mark Hageman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The use of references to claim numbers (see e.g., para. 8) to describe the subject matter within the specification is objected to as this practice may lead to an inaccurate specification when the claims have been amended or cancelled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims -13 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 02/50784 To Matzig. References below are to portions of US 2004/0064413 which applicant has discussed at the equivalent of WO 02/50784.

Matzig (Fig.) teaches an apparatus for executing a money deposit transaction, namely depositing bank notes comprising:

an input pocket (3) accessible during the ongoing money deposit transaction, for inserting bank notes to be deposited,

a checking device (10) arranged to check bank notes inserted into the input pocket at least as to the state of the bank notes and a fitness for circulation resulting therefrom (para. 29, 37-39),

a storage pocket (14) not accessible during the ongoing money deposit

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transaction,

a storage pocket (4, 5) freely accessible during the ongoing money deposit transaction,

a not accessible bank note cassette (15), and

a transport system (9) arranged to transport notes from the input pocket to the checking device, from the checking device to the freely accessible storage pocket, the not accessible storage pocket, and from this into the bank note cassette wherein: the checking device is arranged to check the bank notes inserted into the input pocket at least as to their fitness for circulation (para. 29, 37-39 teaching the transport of not recognized bank notes, under the control of the control unit, into a further, freely accessible storage pocket);

further comprising: a control unit (17), arranged to actuate the transport system in such a way that bank notes not fit for circulation at least partially are transported into the not accessible storage pocket, and bank notes fit for circulation at least partially are transported into the freely accessible storage pocket (para. 29-32);

a display and input unit (6), for the input of criteria for the transportation of the bank notes either or both fit for circulation and not fit for circulation into either or both the freely accessible storage pocket and the not accessible storage pocket (para. 31 et seq. and para. 13 teaching that criteria can be supplied remotely via data transmission thus it is implicit that unit is connected to cash desk). Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be

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capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the device as cited above is certainly capable of having the criteria be changeable or relate to one or more of an amount, a number, a currency and a denomination of the bank notes. In fact, the device allows the user to input specific criteria (para. 34 et seq.). The method claims are anticipated in the normal operation of the device cited above.

### ***Response to Arguments***

2. Applicant's arguments filed 4-16-2008 have been fully considered but they are not persuasive. The reference used in the rejection has been changed to WO 02/50784 as pointed out by the applicant. Applicant stated,

"Matzig fails to disclose that the bank notes recognized as not fit for circulation are at least partially transported into a storage device not accessible by the operator during an ongoing money transaction."

Examiner disagrees and contends that the applicant is arguing limitations that are not in the claim. Specifically applicant stated,

"The examiner will recognize that bills identified as not fit for circulation are not the same as bills that are unrecognized, false or forgeries. The latter cannot be recognized as bank notes, while the former are recognized as authentic bank notes."

Examiner disagrees and contends that the specification fails to set forth a specific definition for fit and unfit bills that would require this narrower interpretation of the claim. Examiner contends that false and forged bills are not fit for circulation when the claim language is given its broadest reasonable interpretation and therefore Matzig

anticipates the claims in that such false bills are sorted into an inaccessible area of the machine. Furthermore examiner notes that paragraph 39, relied upon by the applicant, is but one example of possible control configurations. Also relative to the Applicant's discussion of Goai et al examiner notes that the applicant's claim interpretation is narrower than the broadest reasonable interpretation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

MCH